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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/680,535	10/07/2003	Donald E. Mabe JR.	ATTD-1001USDIV	5006

7590 05/16/2005

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EXAMINER
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ARYANPOUR, MITRA

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 05/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/680,535

Applicant(s)

MABE ET AL.

Examiner

Mitra Aryanpour

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10/13/2004 (received 10/18/2004).
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 15-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 15-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 15-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morse (298,111) in view of Bey (1,324,789).

Regarding claim 15, Morse shows a billiard cue having a proximal portion (the butt end - section A) and a distal portion (the tip end - sections C, D and E or alternatively sections B, C, D and E or any combination thereof), said cue comprising: a grip portion (the handle section A) located on the proximal portion (section A) of said cue; a tip (G) suitable for striking a billiard ball located on a distal end (E) of said distal portion of said cue, and wherein said distal portion (sections C, D and E) comprises up to half of the length of said billiard cue (best seen in figure 1; the length is less than half the length of the billiard cue). Morse additionally, shows that weights (hh) can be added to the pockets (the cylindrical openings positioned at the joint between the sections). The weights can be light or heavy and added as deemed necessary to meet the requirements of the individual user (see page 1, column 2, lines 71-96; also figures 3 and 6). Morse does not disclose expressly the use of a slidable grip. Bey shows a cue, wherein the cue has a movable grip (13) that moves relative to the cue. The grip is provided in order to enable more accurate shooting and to assist in drawing the cue ball. In view of Bey it would have been

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obvious to include a movable grip on the distal portion of Morse's billiard cue, the motivation being to enable more accurate shooting and to assist in drawing the cue ball.

Regarding claims 16-18, Morse shows the billiard cue is made of two or more sections (A, B, C, D and E). Morse does not disclose expressly the amount of variation in the diameter between the sections. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to varying the diameter of the billiard cue to meet the specified amounts, because Applicant has not disclosed that varying the diameter to meet the specified amounts, provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with either the diameter as taught by Morse or the claimed diameters because both diameters perform the same function of allowing a player to strike a billiard ball. Therefore, it would have been an obvious matter of design choice to modify Morse to obtain the invention as specified in claims 16-18.

Regarding claim 19, Morse shows the distal portion (combination of sections C, D and E) of said billiard cue comprises is less than 50% of the total length of said billiard cue Morse shows that weights (hh) can be added to the pockets within the cylindrical openings positioned at the joint of the sections; the weights can be light or heavy and added as deemed necessary to meet the requirements of the individual user (see page 1, column 2, lines 71-96; also figures 3 and 6), and the proximal portion (section A) comprises the remaining length of the billiard cue (see figure 1).

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Regarding claim 20, Morse shows the distal portion (sections C, D and E) of the billiard cue has a weight, which is about 60-80% of the total weight of the billiard cue. Note the rejection of claim 19. The weight can be varied to meet any desired requirement.

Regarding claim 21, Morse shows the billiard cue comprises two or more section (A, B, C, D and E) which are releasably attachable (threaded screws f and cylindrical nuts g) to one another, and at least one of the sections (E) is located in said distal portion of said cue and has a substantially greater density (as indicated in claims 19 and 20, the weights can be adjusted to suit the individual need) than the other sections (see page 1, column 2, lines 71-96).

Regarding claim 22, Morse shows one of said sections form the entire distal portion of said cue (see page 1, column 1, lines 12-18). Morse teaches that the pool cue/cane can be made in two or more sections. The more sections the more compact the assembly. As indicated in claim 15, the proximal and distal portions can be configured in any desired manner. Meaning, one could consider just section E as the distal portion or sections B through E could be considered the distal portion. The same can be applied to the proximal portion.

Regarding claim 23, Morse shows the tip (G) is releasably attachable (the tip can be unscrewed; it should be noted that everything is considered releasably attachable) to the distal end (E) of said cue (see page 2, column 1, lines 49-54).

Regarding claim 24, Morse shows the tip (G) comprises a surface for striking a billiard ball, and an elastomeric material (the broadest reasonable interpretation of elastomeric would include elastic cue tip G) attached to said surface, said elastomeric material being sized to fit snugly over the distal end of said billiard cue to releasably secure said tip to the distal end of said billiard cue (see figures 8, 11-13).

Regarding claims 25 and 26, Morse shows the tip can be formed from an elastic material such as leather or similar material and it is provided with a bearing-plate. Morse does not disclose expressly the specific material(s) that can be used to form the tip. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to use a tip made from neoprene or liquid steel, because Applicant has not disclosed that using a liquid steel tip or a neoprene tip, provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with either the tip taught by Morse or the claimed tip(s) because both tips perform the same function of striking a billiard ball. Therefore, it would have been an obvious matter of design choice to modify Morse to obtain the invention as specified in claims 25 and 26.

Regarding claim 27, Morse as modified in view of Bey shows said grip (13) comprises a tubular elastomeric material, which can be stretched and slipped over the proximal end of the proximal portion of said cue (page 1, column 1, lines 51-56; column 2, lines 57-59).

### ***Response to Arguments***

3. Applicant's arguments filed 13 October 2004 (received 18 October 2004) have been fully considered but they are not persuasive. Morse provides a sectional cue and cane that is formed by connecting two or more parts (A-E) together to form either the cue or the cane. The sections are provided with weighted pockets. The tip is made of an elastic material and it is secured to the distal end (E) using a screw or combination of screw, glue or adhesive material and a plug. Morse shows that it is desirable to provide a cue or cane that is easily separated and is provided with interchangeable weights, allowing the weight and balance of the cue to be changed to suit

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the requirements of any player. The claims as presented read on the structure taught by Morse. As indicated above, the distal and proximal portions can be interpreted rather broadly to include one or more of the parts (A-E). Meaning the distal portion of the cue stick could be considered as having parts (B through E) and the proximal portion having only part (A). As can be seen any combination of parts can form the distal or proximal portions. The claims merely require that the distal portion comprise up to half of the length and more than half the weight. Then the distal portion of the Morse reference could be interpreted as having parts E, D, C and a portion of B. Morse also teaches any combination of weight can be used. Therefore, one may choose not to include weight in the proximal portion (part A) and to distribute the weight more towards the distal portion of the cue.

With regards to applicant's comments that Bey does not cure the deficiency of Morse because it does not contain any teaching, suggestion or motivation to locate substantially more than half of the weight of the cue in the distal half of the cue. The Bey reference was used to show that it is well known to provide a sleeve or grip on cue sticks.

### ***Conclusion***

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mitra Aryanpour whose telephone number is 571-272-4405. The examiner can normally be reached on Monday - Friday 8:00 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 571-272-4415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MA  
23 April 2005



**MITRA ARYANPOUR**  
**PRIMARY EXAMINER**